

REMARKS

Status of the Claims

Claims 1-29 and 31 are now pending in the present application. Claims 1, 9, 24, and 27 have been amended to more clearly to define the invention, but the amendment does not limit the claims. Claim 30 was previously cancelled.

Entry of the Present Amendment

The present amendment of Claims 1, 9, 24 and 27 simple replaces the terms “at least one control key” with “a plurality of control keys.” Since Claim 26 had already recited the phrase, “a plurality of control keys,” no new issue is raised by this amendment to these claims, and no further search is required. Accordingly, the Examiner should enter the amendment and not refuse to do so on the basis that the amendment raises a new issue that would require further searching.

The remarks that follow are primarily directed to the Examiner's interpretation of the menu of coupon categories and mode key defined in applicant's claims, and explain why the recitation of these elements in applicant's claims distinguishes over the cited art. Reconsideration of these specific issues, which are material to the patentability of applicant's claims, should be carried out without requiring applicant to file an RCE. For the reasons discussed below, the differences between the teaching of the prior art and applicant's menu of coupon categories and applicant's mode key do not appear to have been given sufficient consideration by the Examiner, since the existence of these differences clearly should persuade the Examiner to withdraw the rejection of the claims over the art cited.

Analysis of How a Menu of Coupon Categories Distinguishes over Preference Profiles

Applicant has previously attempted to show how the preference profiles disclosed by Williams are distinguishable from the recited menu of coupon categories. The Examiner has responded that he takes a broader interpretation of the claims and views the interpretation of a menu of coupons as being equivalent to a preference profile. However, interpreting a menu of coupon categories as being equivalent to a preference profile is not logically supported by the teaching of Williams, or by the ordinary meaning of the term “menu of coupon categories.” Since applicant has not specifically defined a menu of coupon categories in the specification, the ordinary meaning of the term as it would have been understood by one of ordinary skill in the art at the time of the invention should be applied to the term. Furthermore, the term may not be arbitrarily “broadened” by the

1 Examiner to encompass a meaning outside the ordinary meaning of the term, as that term would have
2 been understood by one of ordinary skill. Williams simply does not disclose a menu of coupon
3 categories and no evidence has been submitted by the Examiner to support a position that one of
4 ordinary skill in the art would believe a menu of coupon categories is equivalent to a preference
5 profile.

6 The Examiner is correct in pointing out that Williams teaches preference profiles can be used
7 to filter coupons. However, the further conclusion that a preference profile is therefore equivalent to
8 a menu of coupon categories is not merited. Williams specifically states that preference profile can
9 be generated based on observing a user's entertainment selections, or that the user may specifically
10 indicate various preferences when registering with the entertainment network. It is significant that
11 Williams never specifically teaches *how* a user affirmatively completes a preference profile. Based
12 on the disclosure provided by Williams, there is no reason to conclude that a preference profile is
13 generated based on a menu of different categories. Even more significantly, there is no evidence that
14 a user of the entertainment network disclosed by Williams *is informed that a decision to include a*
specific preference in a preference profile will result in the delivery of coupons related to that
preference. It is important to recognize that Williams discloses an entertainment network. When
17 registering for an entertainment network, many users would logically assume that by indicating they
18 are interested in a specific categories such as sports and science fiction, they would receive
19 information about sports programming and science fiction programming offered by the entertainment
20 network. There simply is no evidence provided in the cited art that such users would understand that
21 by indicating a preference for sports and science fiction, they actually will have affirmatively elected
22 to receive advertising information (coupons) related to sports and science fiction, since the choice to
23 receive the delivery of advertising coupons related to a category of entertainment selected is outside
24 the scope of the indicated preference.

25 Simply because both a preference profile and a menu of coupon categories can be used to
26 filter coupons does not mean the two elements are equivalent in the manner in which they function or
27 in any other way. Williams specifically teaches that coupons are to be provided for any interest
28 indicated in a preference profile. According to Williams, if a user affirmatively indicates a
29 preference for sports entertainment (or simply watches sports), sports-related coupons will be sent to
30 that user. That paradigm is functionally distinguishable from allowing a user to select specific

1 coupon categories from a list. When presented a list of coupons, the user is free to ignore categories
2 related to his personal preferences, and to selectively choose to receive coupons about categories in
3 which the user has no personal interest (i.e., categories that would never relate to a preference profile
4 of the user *per se*). For example, a user might choose to receive coupons for items (such as flowers,
5 candy, jewelry, etc.) that the user might want to give as gifts to other parties. Merely because two
6 approaches achieve related results does not mean that the elements are equivalent, particularly when
7 differences in the results that are achieved by the two different approaches can be identified.
8 Applicant's recited "menu of coupon categories" is clearly different than the "personal preferences"
9 of the prior art because applicant's menu is created based on specific choices made by the user to
10 receive coupons in the selected categories, and not to receive ads based upon inferences made as a
11 result of entertainment categories selected by a user. Accordingly, applicant respectfully requests the
12 Examiner to reconsider this issue in light of the preceding remarks.

13 Analysis of How a Mode Key Distinguishes over Separate Read and Save Keys

14 The Examiner appears to conclude that the Read and Save keys disclosed by Mankovitz are
15 equivalent to the recited *mode key*, because applicant clearly intends the electronic coupon to have
16 more than one key. However, the mode key recited in Claims 9 and 26 is distinguishable over the
17 Read and Save keys disclosed by Mankovitz, and the mode key (which is a single key), is
18 functionally distinguishable from any other single key disclosed in the cited art. The Examiner is
19 correct in noting that applicant's claims recite a "plurality of keys." However, there simply is no
20 logical basis to conclude that applicant's recited "*mode key*" itself comprises a plurality of keys.

21 Claim 9 specifically defines the function performed by the *mode key* as follows: "the mode
22 key being operative to select between a storage mode and a redeem mode, such that when in the
23 storage mode, the controller analyzes extracted coupon data and saves coupons corresponding to a
24 selected coupon category, and when in the redeem mode, the controller causes a menu of each
25 coupon stored in the electronic coupon to be presented to the user on the display." Claim 26 similarly
26 recites a mode key. Regardless of what any other key of the plurality keys does, these claims indicate
27 that one of the plurality of keys **must** be a mode key, and provide that the mode key **must** be
28 operative to toggle between storage and redeem modes. Mankovitz describes a redeem mode and a
29 save mode; however, those specific modes are accessed using two keys, including a Read key and a
30 Save key (respectively). While the Read and Save keys disclosed by Mankovitz perform similar

functions, the present invention is clearly distinguishable in that a single key is used to toggle between the two different modes. The Examiner has not provided any art teaching or suggesting that the Read and Save keys disclosed by Mankovitz might be modified to achieve the functionality of the single *mode key* specifically described and claimed by applicant.

Claims Rejected under 35 U.S.C. § 103(a)

The Examiner has rejected Claims 1-27, 29, and 31 under 35 USC § 103(a) as being obvious over Williams et al. (U.S. Patent No. 6,075,971) in view of Mankovitz et al. (U.S. Patent No. 5,523,794), and further in view of Small (U.S. Patent No. 5,808,689) and Terrill et al. (U.S. Patent No. 6,052,755). The Examiner asserts that Williams discloses a setup mode, which enables users to complete preference profiles that can be used to filter coupons, that Mankovitz discloses a portable coupon including keys, memory, a controller and a display; that Small discloses encoding and decoding data using the horizontal overscan portion of a video signal; and that Terrill discloses that RAM and ROM can be used interchangeably. The Examiner appears to conclude that an artisan of ordinary skill would have been led to combine and modify these references to achieve an invention equivalent to applicant's claimed invention in order to provide a more versatile system and method for distributing electronic coupons. Applicant respectfully disagrees for the following reasons.

Applicant's independent Claims 1, 13, 24, 27, 29, and 31 each share the common element (recited either as a step or as a function implemented by a processor) of enabling a user to select one or more coupon categories from a menu of coupon categories, to filter the coupons to be stored by the electronic coupon. As discussed in detail above, Williams' preference profiles are NOT equivalent to applicant's recited menu of coupon categories. Even if the references are combined in the manner suggested by the Examiner, the result achieved is therefore not equivalent to the invention defined in independent Claims 1, 13, 24, 27, 29, and 31. Because dependent claims are patentable for at least the same reasons as the claims from which they depend, each claim depending on independent Claims 1, 13, 24, 27, and 29 is also patentably distinguishable over the cited art, for the same reasons these independent claims. Accordingly, the rejections of Claims 1-25, 27, 29, and 31 under 35 U.S.C § 103 as being obvious over Williams in view of Mankovitz, Small, and Terrill should be withdrawn.

Turning now to the rejection of Claim 9 and Claim 26, as discussed above, the recited *mode key* in applicant's claims is not equivalent to the two Read and Save keys disclosed by Mankovitz.

1 There appears no basis, other than hindsight, for modifying Mankovitz's dual key configuration to
2 achieve applicant's single mode key. For this additional reason, the rejection of Claims 9 and 26
3 under 35 U.S.C § 103 as being obvious over Williams in view of Mankovitz, Small, and Terrill
4 should be withdrawn.

5 Turning now to the rejection of Claims 2, 24-25, and 28, the Examiner has asserted that an
6 electronic coupon having a housing that is inserted into a decoder having a housing is equivalent to
7 an integral decoder. The Examiner has stated the applicant's recitation of a decoder and other
8 elements as being disposed in a common housing is equivalent to an electronic coupon that has been
9 placed into a port on a separate decoder. While one embodiment disclosed in applicant's
10 specification is an electronic coupon that does not include a decoder and is used by being inserted
11 into a socket on a separate decoder, applicant specifically describes an alternative embodiment
12 (page 9, line 15) in which the decoder is integral with the electronic coupon. The disclosure provided
13 by applicant is brief, but succinct. Thus, applicant does specifically describe a decoder that is integral
14 to the electronic coupon in the specification of the present application, as claimed, in contrast to the
15 exemplary electronic coupon illustrated in applicant's FIGURE 2, where the decoder is external to
16 the housing of the electronic coupon. The Examiner argues that Mankovitz discloses a coupon
17 inserted into a decoder (similar to what is depicted in applicant's FIGURES 1 and 2). However,
18 applicant also specifically describes an integral embodiment of the decoder as being an alternative to
19 the electronic coupon of FIGURES 1 and 2 (where the decoder is a separate unit into which the
20 electron coupon is inserted). Clearly, an electronic coupon having a decoder in the same housing is
21 different from an electronic coupon that plugs into a decoder enclosed within a separate housing. For
22 this additional reason, the rejection of Claims 2, 24, 25, and 28 under 35 U.S.C § 103 as being
23 obvious should be withdrawn.

24 Claims 19, 26, 29, and 31 each recite elements that define an invention distinguishable over
25 the art cited by the Examiner. Each of these claims defines a storage mode that is different from what
26 is disclosed in the cited art and not obvious in view of that art. Such claims recite the step of
27 selecting a storage mode so that coupons are received and filtered, and in contrast, the cited art does
28 not teach storage of coupons as a result of a user's actions. The Examiner has responded by noting
29 that Williams' discloses setting up preference profiles (presumably via key strokes), and once these
30 preference profiles are set up, coupons are filtered based on those preferences. While this is true,

1 applicant has defined a multi-step process that clearly differs from the teaching of Williams. In
2 applicant's claimed invention, in a set up mode, the user *first* selects coupon categories from a menu.
3 Although as discussed above in detail, Williams' preference profiles are NOT equivalent to a menu
4 of coupon categories, creating a preference profile is a set up operation. Once completed, William's
5 set up operation enables automatic filtering of coupons. In contrast, once a user is finished with the
6 set up mode as defined by applicant's claims, coupons are not filtered until a user *additionally*
7 affirmatively selects the storage mode. According to Williams, coupon filtering occurs automatically
8 after the preference profile is produced. As defined by applicant's claims, coupon filtering requires
9 **both** selecting coupon categories from a menu, AND selecting a storage mode. If the coupon
10 categories are selected and the storage mode is not affirmatively selected, no filtering occurs. In
11 contrast, once Williams' preference profiles are completed, filtering is automatic and no additional
12 action by a user is required to initiate the filtering operation. Clearly, affirmative user action in a set
13 up AND selecting a storage mode are distinguishable over the prior art approach of generating a
14 preference profile and automatic filtering. For this additional reason, the rejection of Claims 19, 26,
15 29 and 31 should be withdrawn.

16 In view of the preceding amendments and remarks, it will be apparent that all claims in this
17 case define a novel and non-obvious invention. The application is thus in condition for allowance
18 and should be passed to Issue without delay. Should any further questions remain, the Examiner is
19 asked to telephone applicant's attorney at the number listed below.

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21 Respectfully submitted,

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28 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed
envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents, P.O.
Box 1450, Alexandria, VA 22313-1450, on March 4, 2004.

29 Date: March 4, 2004

